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In the Supreme Court of the United States

OCTOBER TERM, 1939.

THE SCHRIBER-SCHROTH COMPANY,
Petitioner,
vs.
THE CLEVELAND TRUST COMPANY,
CHRYSLER CORPORATION,
Respondents.
No. [redacted] 9

THE ABERDEEN MOTOR SUPPLY COMPANY,
Petitioner,
vs.
THE CLEVELAND TRUST COMPANY,
CHRYSLER CORPORATION,
Respondents.
No. [redacted] 10

THE F. E. ROWE SALES COMPANY,
Petitioner,
vs.
THE CLEVELAND TRUST COMPANY,
CHRYSLER CORPORATION,
Respondents.
No. [redacted] 11

BRIEF FOR PLAINTIFFS-RESPONDENTS, ON THE PETITION FOR WRIT OF CERTIORARI OF THE DEFENDANTS-PETITIONERS.

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In the Supreme Court of the United States

OCTOBER TERM, 1939.

THE SCHRIBER-SCHROTH COMPANY,
Petitioner,
vs.
THE CLEVELAND TRUST COMPANY, CHRYSLER CORPORATION,
Respondents.
No. 650.

THE ABERDEEN MOTOR SUPPLY COMPANY,
Petitioner,
vs.
THE CLEVELAND TRUST COMPANY, CHRYSLER CORPORATION,
Respondents.
No. 651.

THE F. E. ROWE SALES COMPANY,
Petitioner,
vs.
THE CLEVELAND TRUST COMPANY, CHRYSLER CORPORATION,
Respondents.
No. 652.

BRIEF FOR PLAINTIFFS-RESPONDENTS, ON THE PETITION FOR WRIT OF CERTIORARI OF THE DEFENDANTS-PETITIONERS.

The Respondents herewith respectfully point out that in their opinion the present petition should be denied.

(1) There is no diversity of decision between Courts of Appeals below (*Keller v. Adams*, 264 U. S. 314, 319; *Layne v. Western Well*, 261 U. S. 387, 393).

(2) No question of public interest is involved. The questions presented by the defendants are merely the ordinary questions of validity and infringement which are

presented and decided in any patent suit and there is no more reason for this Court taking up these causes on the defendants' petition than for taking up any and every patent cause decided in any Court of Appeals. These causes were taken up by this Court before because there was present a combination of (a) "the doubtful validity of the patents" and (b) the concentration of the automobile industry in the Sixth Circuit. The latter alone cannot be reason for taking up the causes because a great many of the decisions of the Sixth Circuit Court of Appeals relate to patents in the automobile industry and this Court has consistently refused to take them up for this reason alone. (For example, this Court recently denied petition for certiorari in the cases of *General Tire & Rubber Company v. Fisk Rubber Company,* 84 L. Ed. 85 and *Dayton Motors v. Stagnaro,* 307 U. S. 627, presented on such grounds.) Only when on second petition for rehearing the question of "the doubtful validity of the patents," due to a question of disclosure, was presented in combination with the concentration of the automobile industry in the Sixth Circuit did this Court take up these causes. As we understand it, the causes were taken up because of the presence of the two elements of doubtful validity upon the particular question and the concentration of the automobile industry in the Sixth Circuit. They were not taken up, as we understand the situation, because of the presence of *any* doubtful question of validity and that concentration. Denials of other petitions for certiorari from the Sixth Circuit Court of Appeals in patent cases relating to the automobile industry where it was represented that questions of doubtful validity of the patents were involved, have been denied. Here there are presented as questions of doubtful validity of the patents only such questions as have been presented in these other petitions for certiorari to the Sixth Circuit

Court of Appeals in automobile cases which this Court has denied.

(3) We do not presume to say what the Court of Appeals had in mind (beyond what that Court said) in the footnote at the bottom of the second page of its opinion (p. 2397) regarding the possibility of the institution of a suit in another Circuit under the Declaratory Judgment Act. It is reasonable to assume that one thing the Court might have had in mind is the waiver of venue in the Federal Courts by a corporation who registers in a foreign state (*Neirbo v. Bethlehem*, 84 L. Ed. 123 and *Oklahoma v. Oklahoma*, 84 L. Ed. 329). Each of the plaintiffs is a corporation and we are informed and believe—though it is not of record—that each is registered in states in other circuits than the Sixth Circuit.

HARD CASES SHOULD NOT MAKE BAD LAW.

Throughout its petition and brief thereon, the petitioners parade (1) Aluminum Company of America and (2) the so-called "patent pool," as if the petitioners hope to make out a hard case on one of these propositions and on the basis thereof this Court is asked to make bad law.

(1) Aluminum Company of America is no more than a non-exclusive licensee under the patents in suit, as was held by the Master against the contentions made here by the petitioners who took no exception to such ruling. Whether Aluminum Company of America has done anything reprehensible or not is a question in issue in the United States District Court in the Southern District of New York and now on trial there. That question no doubt will be given proper and extensive consideration by Judge Caffey before whom the case is on trial and justice will be done on the evidence presented on the issues there made up as is fitting and proper under our system

of the administration of justice. Whatever may have been the conduct of Aluminum Company of America it is therefore not, and should not be, made a reason for making bad patent law in these causes.

(2). The so-called "patent pool" consists of what is more properly called a patent estate for which the plaintiff herein is the trustee. This estate was started by an inventor and is participated in by several inventors. Aluminum Company of America was brought into the pool after it was formed. The so-called patent pool was organized more than twenty years ago by individual inventors who could do nothing alone; its entire net receipts from royalties belong to its certificate holders. Through issues of certificates in exchange for patents and through changes in ownership there are outstanding about 4500 certificates. 1100,—a little less than one-quarter, belong to Aluminum Company of America; 1100 belong to the Bohn Aluminum & Brass Corporation (of Detroit,—a company having no financial relationship to Aluminum Company of America); 600 belong to the Packard Motor Car Company, and the remainder (about 1700) belong to individuals, inventors and associates (R. p. 271).

The question of whether or not it is proper and lawful for individual inventors and patentees to group their patents and trustee them is a question for Congress to decide. We are informed and are convinced that legislation for dealing with these questions is either proposed or pending before Congress at the present time, and therefore there is less need for its being presented here as a hard case to justify a request for poor law than if the question were an open one. The formations of these estates has resulted from the inability of individual inventors to bear the burden of protecting their rights under the patent law against such defensive tactics as have been employed here and nothing better illustrates this inability

than the instant suit. First, the District Court did not have the time to try the causes, so a Master was appointed. The Master spent many days trying all the defenses known to the patent law and as a result a record was built up which cost around Five Thousand Dollars to prepare for the Court of Appeals. Even this sum is beyond the means of the average individual inventor. The causes have been twice before the Court of Appeals and once before this Court and now, after a lapse of nine years since the Bill was filed, proceedings are pending asking this Court to take the causes up again. Against such defenses individual inventors are forced to enter these patent estates if they are to have any hope of realizing anything for the time and efforts which they have made in making their inventions and taking out their patents. The making of bad law for the purpose of striking at the patent pool would result in increasing the defenses available to infringers, further complicating patent litigation and increasing the reasons why inventors must go into patent pools if they expect to receive anything from their inventive efforts.[1]

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[1] The first patent pool on record was formed a little less than one hundred years ago by Elias Howe, the inventor of the sewing machine. Although it is difficult at this time to appreciate the tremendous benefits that resulted from the invention of the sewing machine, we still have some conception of its importance. Howe knew nothing but poverty and distress as a result of his invention until a pool was organized including his patent. After the formation of the pool he realized substantial benefits financially and otherwise from his invention. His genius was released from his fight against poverty and distress to be utilized in other inventive work. On the contrary, Goodyear, who made the most useful and revolutionary invention of vulcanizing rubber, entered no pool, but spent the rest of his life in poverty and distress (See *March of the Iron Men*, by Burlingame, 1938, pp. 360 to 372 and 306 to 310). Howe entered the patent pool and could, to quote Mr. Burlingame, "sit back at last from his labors" to profit from his invention. Goodyear entered no patent pool and "when the Cross of the Legion of Honor was awarded to him, the news thereof was brought to him at the debtor's prison in Clichy."

Instead of making bad law to still further complicate the administration of the patent law and thereby to increase the burden on inventors and reasons for such things as patent pools, it is important to preserve the patent law as it was during the long period when industrial progress increased under the fostering administrations of that law.

These statements are justified by the following findings appearing in the Report of the Monopoly Investigating Committee, headed by Senator O'Mahoney, and made about January, 1939:

> "1. There seems to be a general agreement by these witnesses, as well as by those who previously testified at the Department of Justice hearings some weeks ago, that inventors and business still need the protection and stimulation of patents."
>
> * * * * *
>
> "the patent system has been of inestimable benefit to the country in promoting industrial and scientific development, and may be regarded as one of the principal causes of American industrial supremacy,"
>
> * * * * *
>
> "(6) The fact that patents are keystones in many very important industries has been brought home to us with great emphasis. I doubt whether I had realized their significance as a primary force in the operations of the economic system."
>
> * * * * *
>
> "(7) There was practically unanimous agreement among the witnesses that Congress, by the enactment of the Patent Law, has given this country a system far superior to that which exists in any other country."

In a rapidly changing world we must stand—if we can stand upon anything, on the facts found by a Committee of Congress that has made such a careful and exhaustive investigation of an institution. If our patent institution is as valuable as the Committee finds, it is reasonable to con-

tend that we should preserve the rules and practices under which it has been built up and not rock it by changing the rules and standards to make it more difficult to encourage invention. Indeed, it would seem that if there is any change to be made, that change should be to favor the inventor.

"Bad Law" which would result from the proposals of our adversaries, are the following:

(a) A different rule of interpretation for the prior art and for the patent in suit; they always have been the same and should be the same.

(b) It is proper that a claim should be interpreted in the light of the specification. This is a contract rule and not particular to a patent, and if changed in the patent law, it should be extended to the contract law.

(c) Combination claims are properly considered as if the combination was a separate legal entity from the elements (*Leeds & Catlin v. Victor,* 213 U. S. 301); that to consider the invention as one element is to change the whole basis of the patent law.

(d) Where a patentee mentions a feature like "flexible webs" in his patent specification, he is not to be presumed to have abandoned it merely because he does not reiterate it in his arguments before the Patent Office.

(e) The rule of proving a prior use beyond a reasonable doubt is a sound rule and should not be changed as must be done if the Long piston is to be held to be prior to Jardine.

(f) The rule of sufficiency of disclosure for prior uses and prior patents has always been the same. It should not be changed. It is just as easy to reproduce a device from a drawing as from a prior specimen. Indeed, in many ways the drawing is more reliable because it does

not change over the years, whereas the prior device through wear, use and obsolescence often changes. Today more devices are made from drawings than from copying mechanisms because the drawing is the better guide. To change the rule now and ignore the Long patent, No. 1,872,772, and its instructions, and to be guided by the oral evidence regarding a specimen of the Long piston would be not only to change the established rule of patent law on the subject, but to fly in the face of experience in the industries.

(g) The rule in *Waterman v. McKenzie,* 138 U. S. 252, is a good rule and should not be changed.

(h) The rule that where a party fails to except to the finding of a Master against him he abandons the issue so decided, is a good rule and should not be changed; there ought to be an end to litigation and questions once put at rest should remain at rest.

The learned Judges who in the past have tried and decided the many patent cases upon which these rules have been based, possessed a sound understanding of human psychology and displayed profound wisdom in establishing these principles. They are not lightly to be changed for the purpose of striking at what in passing moments may be considered to be bad cases whose disposition, if they are bad cases, is properly before other tribunals or before Congress.

THE FACTS.

The "Summary and Short Statement" on pages 2-8 of the petition is full of inaccurate or half-true statements, fertile with misleading.

The primary and outstanding fact, against the background of which all the contentions as to petty details must be viewed, is that for many years the most expert engineers in the United States and abroad in automotive development had endeavored to devise a completely successful aluminum piston for iron cylinders of automobile engines, and every effort had been a practical failure, so that in the trade aluminum pistons had a "black eye." As against this history of failure, the Jardine type of aluminum pistons was successful theoretically and practically. This type could be installed when cold with a clearance of only 2/1000 of an inch; was strong and sturdy enough to last for scores of thousands of miles; and would operate at high speed and intense heat without expanding enough to seize or "set up," and without scoring either piston or cylinder. Because of these achievements this type as refined by Maynard was in a short time universally adopted by almost the entire industry which used aluminum pistons, and they displaced iron pistons excepting in a few instances. The Jardine piston, as refined by Maynard, had a use of millions, and, when modified in plainly immaterial particulars, was used by the actual defendant in this case, the Sterling Company, and by different ones of the plaintiff's licensees to the extent of many millions.

Another thing which has been used to becloud the issue is the constant attack upon the Aluminum Company of America, as if it were the plaintiff in this case and as if, had it been plaintiff, attacks upon it would make a good defense to this suit.

We proceed to note specific corrections which should be made in petitioner's Statement of Facts.

Page 3, line 12:

That the Aluminum Company of America was an exclusive licensee, so that it must be a party plaintiff, was a point made by defendants (petitioners here) before the Master. It was *overruled* by him (R. p. 1097 & 1105 & 1106). Defendants took no exception. The point was not raised and was not open, in the District Court or in the Circuit Court of Appeals, on the first hearing. To the attempt to raise it in the Court of Appeals on the second hearing, that court said (R. pp. 2405 and 2406):

> "The appellants, however, contend that the decrees should not have provided injunctive relief to the appellee Trust Company on the ground that it is the bare title holder of the patents in suit, with the Aluminum Company of America as exclusive licensee the only party entitled to seek it. They thereby deny our power to grant restraint in respect to claims now found valid and infringed. The master, however, concluded that the Trust Company holds the entire right, title and interest to all patents in suit except an undivided half of the Maynard patent, that it might sue in its own name without joining with it the beneficiaries under the trust, and that the Aluminum Company is a non-exclusive licensee and not a necessary party to the suit. No exception was taken to his findings or conclusions in this respect, and they were not challenged when the case was first before this court. The right of appellees to injunction was no longer in issue when we gave direction for mandate. It is now the law of the case that appellees are entitled to an injunction restraining infringements of any claims of any of the patents in suit now adjudicated as valid and infringed."

The question is not open here.

Page 4, lines 13-16:

The Circuit Court of Appeals did *not* hold that the presence of flexible webs in Jardine distinguished him from the prior art; it only observed that webs, having as a characteristic the necessary flexibility, were present in the structural combination which constituted the invention of the claims in suit.

Page 4, line 25:

The holding of the Circuit Court of Appeals as to Jardine is *not* contrary to, but is in accord with, the former decision of this court in these cases. This court, at the importunity of defendants, having made the strict rule of interpretation of the law of these causes, defendants are complaining when the Court of Appeals applied that rule to defendants' prior art. Now it is defendants' ox that is gored.

Page 4, line 30—page 5:

Jardine did *not* surrender his right to have the necessary flexibility considered as a quality of his webs. Jardine originally presented seven claims (R. pp. 234-6), some of which were essentially equivalent to the finally issued claims 1, 8, 11. No one of these original claims recited "flexible" before webs. Other pending applications (Gulick, Long, Maynard, Hartog) had claims which more or less vaguely did recite yielding or bending as characterizing their respective skirt carriers. The Examiner directed fourteen separate interferences.[2] Pursuant

[2] It should be noted that the declarations of interference (R. pp. 2068 to 2105) do not specify the particular Long application with which the interference was declared. Various interference decisions found in the record (No. 49570, p. 1548, No. 49571, p. 1565, No.

to this direction, Jardine took from some of the other applicants and added to those he then had, six claims which recited yieldability or bending of the "arms," "carriers" or "connecting means." (No one of these claims mentioned "flexibility" or "webs"[3] (R. pp. 2069-2100)). The others copied some of Jardine's existing claims. No one of these six claims depended upon its "yieldability" or "bending" to distinguish it patentably from the prior art; that recited quality did not *per se* give inventive character to any one of these claims. Each claim was to a complete structural combination in which the "joining means" had, because of its arrangement in the combination, the quality necessary to cause the structural parts to work as described. In such of those interferences as were decided against him, Jardine did not lose this same quality in his own structure. He lost the particular structure-formula recited in each. For example, he lost (to Gulick) interference No. 49,572, but this interference called very broadly for "means" joining the bosses and the skirts (R. pp. 2077-8). Jardine's claims in suit are restricted to the particular means rightly called "webs" or things equivalent, and are restricted as well to the longitudinal slot not named in this interference count.

Then his patent issued, upon the claims he had before the interference, somewhat rewritten and revised, but not

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[3] In one interference only, out of these six, it was recited "said skirt carriers being disconnected from the wall portion of the head and susceptible of being slightly flexed radially" (not laterally) (R. p. 2087).

(Footnote 2 continued)

49575, p. 1541) do specify that the Long applications involved were not the application which resulted in Long patent 1872772 but were based upon other Long applications not found in the record. Interference 49569 (R. p. 1533) is the only one found which does seem to involve the same Long application which resulted in his patent 1872772; and in this decision Long's claim to the 1916-17 conception and reduction to practice is discussed and discredited (see *infra*, pp. 14 and 15).

changed in any respect now material. There had been no occasion to "stress" web flexibility in the arguments. It had not been the "carrying" feature.

Page 6, lines 5-7:

It *is* clear that the Jardine claims in suit *were* "put forward" as combinations of structural elements including webs which would operate and thereby permit the split skirt to operate,—all as carefully described in the specification (Patent p. 1, lines 90-100, p. 2, lines 1-33, R. pp. 1295-6).

*Page 6, Footnote *:*

Long did *not* prevail over Jardine in any interference "including flexible webs." The printed record does not show who prevailed. In fact, in the six interferences where the particular claim in issue recited "yielding" or "bending" Gulick prevailed over both Jardine and Long. There was no decision as between Long and Jardine on any such issue. Gulick prevailed because it was then believed that his original specification sufficiently indicated lateral flexibility,—a conclusion which this court has reversed; and Jardine's filing antedated the Gulick amendment by some three years.

Page 6, the Long use and sale:

This section of the brief is very misleading. Long's patent 1872772 (R. p. 1736) (selected on the former hearing as the typical and vital Long invention) so definitely shows that the "webs" were rigid that petitioner has abandoned this patent as the basis of its claim, and has gone to an alleged physical embodiment, Exhibit F, one of Long's many pistons. Under the long established rule

of this court[4] that anticipating proof must be clear and convincing, even beyond reasonable doubt, and that recollection of twenty year old events unaided by records of any kind is insufficient, the existence of Exhibit F before March 11, 1920 (Jardine's filing date) is not proved.

To establish Long's early dates petitioner in this case did not call Long, who was then available in Detroit, though he evidently must have been the most competent witness. This may well have been because Long's testimony had been so discredited in the interference years before when recollection would be better. The Examiner said (he was affirmed by the Board) (R. p. 1535):

> "Here again as in connection with count one, Long is testifying as an item of sheer memory. The unaided memory of a witness testifying ten years after an event as to a large number of one of similar pistons is not sufficiently reliable. * * * There is no satisfactory corroboration for Long's claim." (Examiner here comments adversely, p. 1536, on the testimony of Stellman and Royalty who are also supporting witnesses in the present case.) (R. p. 1537) "Long's entire case for priority of conception is in substance based upon the unaided memory of several witnesses speaking about ten years after the event and speaking then with a degree of uncertainty that is inevitable under such circumstances. Long had fifteen to twenty applications for split-skirt pistons on file at the time he was testifying and had built a great many different forms for which no application was made. It was thought that no one after a period of many years would be able to recall the particular year when he saw a specific structure of any particular kind of piston from a large number of similar pistons, unless there was some special fact that had impressed upon the mind of the witness this particular

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[4] *Barbed Wire Case,* 143 U. S. 275; *Deering vs. Winona,* 155 U. S. 286; *Symington v. National,* 250 U. S. 383, 386; *Smith v. Hall,* 301 U. S. 216, 222; *Coffin v. Ogden,* 18 Wall. 120; *Mumm vs. Decker,* 301 U. S. 168, 171.

year and structure. The Long case for priority is fatally defective."

No documentary evidence was offered here that was not before the Patent Office for repeated critical examination during the nine years of the interferences.

Petitioner,—as in all previous hearings,—takes advantage from this confusion arising from the multitude of "Long pistons." During the period 1918-1923 Long filed in the Patent Office at least sixteen different applications[5] (p. 1532). As to the specific details of most of them, the record is silent. Until after 1920 (and even later) Long was constantly engaged in changing and changing, trying to overcome demonstrated defects. It is beyond reason to suppose that any witness, testifying in 1933 from memory about events of 1916-1920, could definitely remember that the piston put before him in 1933 (Exhibit F) was the particular one of the many similar Long pistons used before March 1920, rather than like one of the forms in much greater use in 1921-24; and there is no documentary confirmation.

On page 7 of the petition is quoted the comment of this court, "the Long piston, whose webs concededly were laterally flexible."[6] This was an unfortunate misapprehension, for no such concession was ever made, and the record does not justify any such statement with the inferences which petitioner makes. The supposed basis for it arose

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[5] This list shows eleven applications but it is evident that cases B, C and K were for some reason omitted (perhaps they had been closed), and the list does not contain the serial numbers of the applications which resulted in patents 1,395,441 (R. p. 1728) and 1,489,499 (R. p. 1732). This makes a total of sixteen. The Examiner said (R. p. 1537) that "Long had fifteen to twenty applications for split-skirt pistons on file at the time he was testifying."

[6] This statement might have been satisfied by the form of Long piston in use about April, 1923 (the date of the Gulick amendment). In the present case, the particular Long piston with its supposed web flexibility, must be carried back of March, 1920.

in this way: The expert witness for respondent (plaintiff be'ow) was shown Exhibit F and asked if there was web flexibility. The question obviously referred to its condition at that time, in his hands and not when in use. The question had no reference to its performance in a cylinder while in operation. The witness said, "there is flexibility in the webs" (R. p. 1010). An inspection of the exhibit clearly shows that the free edges of the skirt at the six slots will yield a trifle to direct pressure, but also shows upon such inspection and handling that no web flexibility can possibly develop in an engine because of the relation of the webs to the remainder of the structure. It is clear that what the witness meant was that the web would flex if sufficient bending force were put upon it, just as he had been saying about the webs of the other structures. *His answer does not touch the question whether the webs would flex in actual operation.*

At pages 6 and 7 of defendant's petition, a single question and answer relating to this subject is quoted from the testimony of Dr. Jeffries, the plaintiff's expert at pages 1009 and 1010 of the record. There is always danger in accepting such an isolated question and answer without considering the context. When we consider the context on pages 1009 and 1010 of the record, we find that not only is the conclusion which the defendants seek to draw from the single question and answer erroneous, but that the Long piston was far afield from the Jardine invention. The witness was handed the pistons, Exhibits E and F, and asked about the flexibility of the webs. The witness said he had seen many trunk type pistons with no slots at all that have the same kind of a surface as Exhibit E, and *that the hard rubbing opposite the webs on Exhibit F showed that the webs had expanded out and pushed the cylindrical part of the piston skirt against the engine*

cylinder in operation. From this it was clear that the webs had not flexed in use but, on the contrary, instead of flexing and yielding so that the cylindrical parts of the piston would not rub against the cylinder wall, the webs had acted rigidly, as Long said they would in his patent, and pushed the cylindrical parts of the piston skirt up against the engine cylinders so hard that there was rubbing even at the .005 clearance which the Franklin Company found it necessary to give the Long piston as against the .002 clearance sought for and secured by Jardine. After the settlement of this question the witness was then asked if, nevertheless, the webs were not flexible. This was the question and answer quoted in the defendants' petition. The witness replied that they were, clearly having in mind that it was possible to flex them by hand or otherwise notwithstanding they did not flex in use as evidenced by the rubbing, concerning which he had just testified, and thus disposing of any claim that they might have flexed in use. Proceeding down page 1010 the witness then gave the history of the Long piston which corroborates his testimony and the conclusive evidence furnished by the rubbing to which we have just referred. In giving this history the witness said that the "Long pistons were not satisfactory" and that those who were continuously in touch with the Franklin Company would "come back with repeated tales of how they were not satisfied" with these Long pistons, and that they were finally abandoned, after which there were no complaints (R. p. 1011). Thus, when we examine the context of the question and answer upon which defendants rely, we find that the witness having already shown through indisputable evidence on the piston Exhibit F itself that the webs did not flex, stated that they could be flexed, meaning that it was possible to flex them by hand even though they did not flex in use. As we are here concerned with flexibility

in use and not flexibility by hand, the conclusive evidence of the lack of flexibility in use, based on the rubbing found opposite the webs of Exhibit F, is all that matters. What could be done by hand or under other circumstances is immaterial.

This Exhibit F was made at some time after November, 1919, because it bears the stamp of Weems as maker and he did not take over the Long business until November, 1919 (R. p. 1625). No one knows when it was made (before or after March, 1920), where it had been in the meantime, or how it came into the possession of defendants' counsel. Plainly, this testimony is not an admission that every one of the various forms of Long's pistons before March, 1920, had web flexibility, even when cold and manipulated by hand,—much less that they would have that capacity under the conditions existing in an engine cylinder in operation. There is no identification of Exhibit F as being the 1916-19 Long pistons, except the oral testimony of witnesses (with no documentary evidence whatever), that Exhibit F was "like" the earlier ones. It is hardly conceivable that such evidence would be sufficient even if it might be assumed that Long and Weems had been making the same thing from 1916 to 1921; but it cannot be sufficient against the existing background of many different forms in many different patent applications filed within that period,—to say nothing of forms that never reached the stage of application for patent.

The record shows only three of the Long patents. No. 1,395,441, filed December 9, 1918 (R. p. 1728), contains no webs at all. The whole skirt is carried by and depends from the edge of the head. No. 1,489,499, filed December 9, 1918 (R. p. 1732), has no web carrying bosses and skirt. The parts 8*8* (Fig. 5) are rigid braces from the bosses to the thrust side of the skirt to resist

the thrust and prevent any bending of the opposite side of the skirt (lines 103-106, p. 1, R. p. 1733) and are so tied together by the skirt that they can not flex. No. 1,872,772 (R. p. 1736) filed March 7, 1919, still retained Long's earlier plan of having the controlling portions of his skirt (4,4) depend directly from the edges of the head (Figs. 1 & 2) and carry the pin bosses, with no provision for or possibility of yielding or flexing in those skirt portions 4, because they would be unyieldingly carried out against the cylinder by the thermal expansion. Then, four sections of the skirts (6,6) being two on each side, were completely severed from the main skirt so that they would fall away, unless prevented; and this was prevented by carrying these four sections from the pin bosses by "connecting sections" 10 (lines 54-60, R. p. 1737). These "sections" respondent now calls "webs," though they plainly are not the "webs integral with the head" and, "carrying the pin bosses" of Jardine. Whatever name is given them, they are not flexible or bending or yielding. Not only would this be impossible in operation,—for they are attached to sections 6 at the center of 6 and any thermal circumferential expansion in 6 would pull the connector 10 equally in opposite directions,—but Long said (p. 2, line 25) that they reinforce the sections 6 and hold them outwardly against the forcing thrust of the connecting rod so that they "will be *rigidly* held against bending" (line 33, R. p. 2),[7] while in Jardine (R. p. 1294) (as in Gulick, Maynard and this infringing Exhibit 1) the circumferential expansion of the skirt to close the slot, as well as any radial

[7] In Exhibit F, as partially shown in the drawings of patent 1,872,772, the free sections 6,6,6,6 carry at top and bottom, and sections 4,4, carry at their free bottom edge stiffening flanges plainly intended to prevent flexibility, and to compel the section to respond as a whole to the supposed (mistakenly supposed) compression by the cylinder.

expansion of the web, tends to bend the webs in one direction only.

Whatever the character or date of Long's piston, as actually made and sold, the six slotted form was a "contraption" having a skirt with twelve free (and possibly vibrating) edges,—a skirt which, unless it departed from the patent, had six points at which it could not be distorted by cylinder pressure in operation (the top and bottom pin boss connections (Fig. 5, R. p. 1736) and the four connector 10 junctions with the skirt) and it could not and never did operate upon the principles of the Jardine-Maynard form, which permitted assembly cold, with a clearance of only 2/1000 of an inch.

This is demonstrated by the experience of the Franklin Company. Respondent would have us believe that it was early in 1916-17 that Long had completed his experiment and developed Exhibit F and shown it to the Franklin Company, through its superintendent Spellman. On April 13, 1918, Long wrote to Franklin that he wanted to interest them in a "patented piston" he had (R. p. 1446) and May 9, 1918, he was told by the chief engineer to send one on for trial (R. p. 1445). On July 20, 1918, on a test, the piston "set up" (froze) in nineteen minutes. On October 5, 1918 (R. p. 1438), on another test, a full set was installed in a Franklin car, with a clearance of two or three thousandths; after ten minutes the piston seized; then they decided to try a 5/1000 clearance. In March, 1919, Mr. Spellman reported to the Franklin Company that Mr. Long "had a new design for aluminum pistons" (R. p. 1629) and that there had been a road test of 970 miles (an entirely insufficient test for sturdiness). The clearance was not given, but the cylinders were scored (R. p. 1631). Some test was in progress in May, 1919, covering a Long piston with "floating

wrist pins," whatever that was (R. p. 1440). The test showed excessive wear of parts. On April 8, 1920 (R. p. 1587), the Franklin Company announced that after April 15, 1920, it could furnish Long type pistons, saying: "While these pistons have not proved satisfactory in production, we find they work very well" in cylinders which had been worn five or six thousandths of an inch. In November, 1920 (R. p. 1588), the Franklin Company announced in a circular to all its dealers that it had at last a satisfactory aluminum piston, plainly admitting that until that time it had not been satisfactory because too large a clearance had been necessary. "A new design has been perfected whereby we are now enabled to fit aluminum pistons with two to three thousandths clearance. * * * This new piston is a distinct improvement." (This was eight monhs after Jardine filed.)

This is a distinct admission that all the Long pistons experimented with up to that time had not solved the aluminum piston problem because they had to be installed with so much clearance that they slapped, and it eliminates from the field of Jardine's anticipation Exhibit F, if in fact Exhibit F was the thing which Long made before 1920. However, even as late as April, 1922 (R. p. 1590), the Long type had to be installed with a clearance of 5/1000, demonstrating that the problem was not solved even then, and the company was considering abandoning that form and going to the oval type.

The substance of all this is that Long retained as outstanding features of Exhibit F and (probably) many of his other early pistons, two skirt sections attached rigidly to the ends of the pin bosses and four sections carried at their centers by a rigid connection,—such that the supposed slot closing performance of the skirt *could not*

happen, since expansion must stop when these rigid unyielding parts meet the cylinder. These Exhibit F Long pistons did not answer the need, and they only became fairly tolerable in the Franklin engines when, as shown by Exhibits E and G, they were modified by providing around the pin bosses the relief, indicated in the Jardine claims by saying that the skirt was relieved or cut away in the region of the bosses. Even then, they were finally abandoned by the Franklin Company, which substituted one of the later forms of pistons made by one of plaintiff's licensees.

At this large clearance the Long piston slapped (R. pp. 469 and 461) and collapsed (R. p. 939). It was expensive to make (R. pp. 401 and 461) and was too heavy to realize the lightness that was required. Although there was a crying demand for a light aluminum piston (R. p. 458) the Franklin Company was the only one to adopt the Long piston (R. p. 398). There was continual complaint about it (R. pp. 1010 and 1011). It would not stand up and was ultimately abandoned (R. p. 672).

In an effort to support its contention that the Long piston, Exhibit F, was prior to Jardine, defendants cite several pages of the record at page 6 of their petition. A reference to these citations shows that the oral evidence defendants cite to support their claims is vitiated by opinions and apologies for unreliable memories.

At page 378 the witness Chadwick did not say that the Long 1918 piston was like Exhibit F; he expressed *the opinion* that there was practically no difference, but on the next page said by way of warning one of the unreliability of his opinion "it is pretty hard to go back at that time to be exact to the exact design," having reference to the many and confusing designs of pistons of Mr. Long.

At page 441 the witness Royalty stated that Weems continued to make the "types" of pistons "like" Exhibits F and R while he was working for Weems. He did not say that the pistons were the same. As he worked for Weems up until the latter part of 1921, the Exhibit F type of piston may not have been made until after Jardine, and it would still respond to this testimony. In other words, if its making by Weems was begun and continued during the latter part of Royalty's employment by Weems, Royalty's testimony would be consistent with its history at the Franklin Company and otherwise not. We find the same warning about the unreliability of his testimony in his statements on cross examination at page 444 of the record, that during his employment with Weems he "had seen three or four different kinds of slotted pistons of" Long and "there were altogether perhaps four or five different kinds of pistons shown me by Mr. Long" and, further, on the same page, that he did not remember the various changes or the order of the tests on the pistons. At page 350 the witness Venner did not say that the construction of the first Long pistons was like Exhibit F; he expressed *the opinion* that they were practically identical with Exhibit F. This testimony, even if interpreted as defendants ask, is unimportant because there is no evidence of the date. Not only is the claim for the use of the Long pistons injured on cross examination, but the claim that the Long piston was of any value was spoiled by Venner on cross examination. He testified (R. p. 363) that the pistons which preceded his piston were all bad, seizing or slapping, and that this included the Long pistons (R. p. 364). At page 661 the witness did not identify Exhibit F as the piston referred to, but expressed the *opinion* that he could not at that time say that it *differed* from Exhibit F. This is not even oral evi-

dence identifying a piston. This testimony was all taken by deposition and not before the Master. There is no identification of Exhibit F at page 669 of the record. All the witness said was that he saw a certain piston "like Exhibit F" in 1920. Of course, all pistons are alike in some respects and unlike in other respects. There is no identification of this type of piston at page 680 of the record. Moreover, as we have shown, *supra,* this could not have been until in 1920 after Jardine's filing date. This witness also testified about various types of Long pistons. At page 685 the witness Burns, when asked to identify the piston, discussed it and its various features, saying during the discussion "I don't say this was on it." "I mean that seems as though it was later on; I won't say it was or wasn't on there." "I won't say that relief was on there or wasn't on there." This witness also referred to the various Long pistons. Manifestly, such evidence does not even reach the standard of oral evidence which has been emphatically rejected by this Court as sufficient to establish public use in such cases as *Symington v. National, supra,* and ruled as insufficient by this court in such cases as *Smith vs. Hall, supra.* If oral evidence is insufficient, still less so is oral opinion evidence submitted with warning that it is undependable because of the confusion based on a plurality of Long types of pistons.

Petitioner, on page 19, notes that the Court of Appeals "did not dispute the fact that before Jardine's earliest date, which is May 11, 1920, the filing of his application that Long pistons of the character represented by Exhibits E, F, G and R were in existence, etc." The Court of Appeals, for reasons which it states, found it unnecessary to examine this alleged "fact"; but that does not change the record. We have pointed out that there was

no sufficient evidence that Exhibit F (and the same is true of Exhibit R) was in existence before March, 1920; the balance of probability is that these exhibits were manufactured at a later date; and, in any event, both of these exhibits have the integral boss-skirt construction at opposite points on the skirt, with no relief or cut away portion to permit the boss expansion which, without such relief, would inevitably cause a "set up" if installed with the necessary minimum clearance. Exhibits E and G do have such cut away skirt portions and so, at these two particular spots, the essential inoperativeness has been cured; but there is no claim that these exhibits were manufactured before May, 1920. This fatal defect in the Long proof petitioner undertakes to meet only by the unaided recollection of witnesses to the effect that "this relief was always on all the pistons,"—although this is in flat contradiction to the testimony supposed to establish Exhibits F and R as the identical form of the continuous Long-Weems manufacture and in flat contradiction to all three of the only Long patents which were put into the record (R. pp. 1728, 1732 and 1736).

LACK OF IDENTITY BETWEEN JARDINE AND LONG.

Under familiar rules of patent law (*Coffin v. Ogden,* and other cases cited at page 14 of this brief), the burden was upon the defendant to prove identity between Jardine and Long. No proof was offered by defendant on that subject. The only proof in the record establishes lack of identity (R. p. 939). In these premises, counsel undertake to overcome history by logic. It was Mr. Justice Holmes who said that a page of history was worth a volume of logic (*New York Trust v. Eisner,* 256 U. S. 345, 349). We might add that a half page of history, supported by the evidence in the record, is worth two

volumes of hindsight logic of infringers. If we ignore the evidence and the history and weigh the issue of identity in the scales of the hindsight logic of the infringers, we still find lack of identity. We have pointed out that the only documentary evidence upon the Long piston is that of Mr. Long himself, and to the effect that his webs are rigid. If, nevertheless, this Court accepts the argument that they are flexible in use, there is still lack of identity because the principle of operation of the Jardine patent is not based upon web flexing alone. It includes, as Jardine says in his patent, "deformation and deflection of parts" (R. p. 1295, ls. 25 and 26). The full text of the sentence in which this statement is found is as follows:

> "I have found that these difficulties can be overcome by constructing a piston with its skirt or guide portion supported and slotted or divided in a manner to permit deformation and deflection of parts thereof without interfering with the performance of the essential functions of the respective parts."

This is described more in detail in the paragraph beginning at line 89 on the next page of the Jardine patent. There is no such action in the Long piston. There is no claim of any such action even by the hindsight logicians. Not only the description by Mr. Long of his piston, but the physical character of the piston itself is such as to make any such logic untenable.

Page 7 last line and beginning of Page 8:

As explained in the accompanying argument (*infra*, pp. 27, 34, 35), the conclusion of the Circuit Court of Appeals does not involve nor rely upon the theory here recited.

Nor did the Court of Appeals hold that flexible webs were the essence or the essential element of the Jardine

invention. Its frequent reference to the clear description of the flexibility of the webs in the Jardine specification was to show conclusively that the rule made by this Court in its former decision with respect to Gulick and Maynard did not apply to Jardine. But the Court's discussion of the operation of the Jardine patent was not limited to the flexibility of the webs; the court also discussed the description of the features of operation in the Jardine patent based on the "deformation and deflection of the parts" (R. p. 2402) and on the reaction of the engine cylinders on the guide segments (R. p. 2401).

ARGUMENT.

I.

Petitioner's brief pp. 14-17.

The Court of Appeals did not treat "flexing webs" as essential elements, but rather as qualities of an element named. Such qualities were not surrendered during the prosecution of the application or excluded from consideration in interpreting the patent, nor did the Court of Appeals refuse to follow this court.

Only a reading of the opinion of the Court of Appeals is necessary to show that it did not read the flexibility of the webs, *per se*, as an "essential element" into the Jardine claims. The opinion of that court at the first hearing with reference to the Gulick and Maynard patents was at first thought by this court to indicate that such flexibility had been "read into" the Gulick and Maynard claims. This court concluded such supposed action to be erroneous because it was in contradiction of the original Gulick specification and was not mentioned in the Maynard specification. The natural,—indeed the inevitable,—inference from the opinion and modifying order of this

court is that if such flexibility had been properly described in the specification it could rightly have been considered as an important or essential quality of the webs. On further consideration, on motion to modify the mandate, this court withdrew its assumption that the court below had thus read flexibility into the claims, and remanded that question for consideration. In its second opinion, the one now under review, the court below carefully explained that because web flexibility was fully described in the Jardine specification it could properly be considered as a characteristic thereof. The intent and the effort of the court below to follow the opinion of this court in this particular are obvious. (R. pp. 2401, 2402.)

As pointed out in the foregoing statement of facts (*supra,* pp. 9-27), it is a complete error to suppose that Jardine, by entering into the interferences which the Examiner directed, ever intended to or ever did present claims which rested for their patentability solely upon flexibility in the webs. All of the interference counts which mentioned yielding or bending in the webs were directed to complete combinations of elements making up a composite piston structure, which structure was described in different forms of words in the different interferences. The flexibility of his webs was completely described by Jardine in his specification, as one of their qualities which permitted the composite structure to perform as stated. That quality of the webs was inherent in his claims as originally made, before any interferences, and in his claims as granted after the interferences. There is no basis for the suggestion that it was ever given up or surrendered.

The idea that the qualities of an element must be specified in the claim, is a complete fallacy without any support. It was exhaustively discussed in the briefs upon

the former review, and the contrary conclusion is implicit in the former opinion of this court and its action as to the mandate.

No one of the claims in suit, as compared with the prior art, depends for its patentability upon the fact that the webs may yield or bend a trifle, and Jardine never had any such theory in any claim at any time. This quality pertains to precision in operation, but it has nothing to do with the question of invention over the prior art.

Petitioner's error of fact regarding the nature of the interferences is so complete that there is no room for response to the argument based thereon.[8]

We need go no further than the authority cited by our adversaries to show that the rule that one part of a contract may be interpreted in the light of other parts of the contract, applies to the construction of the claims of a patent in the light of parts of the specification. A patent is a contract as all agree. For example, in *White v. Dunbar,* cited at page 14 of our adversary's brief on its petition, the Supreme Court said:

> "The context may, undoubtedly, be resorted to, and often is resorted to, for the purpose of better understanding the meaning of the claim."

In *McCarty v. R. R. Company,* cited on the next page, the Supreme Court said with respect to consulting the

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[8] These interferences were not declared because there was any conflict as to "flexible webs" *per se*. The recited "yielding" or "bending" was an obvious incident of the varying structures, which composite structures were said to be in conflict. For example, the issue in Interference 45972 was (R. p. 2077):

> "A piston having a head with top and side walls, in combination with a guide structure connected thereto and comprising diametrically opposite cylinder-engaging parts formed with air spaces between the upper edges and the bottom edge of the side wall of the head, wrist pin bosses between the cylinder-engaging parts, and the means joining said bosses and cylinder-engaging parts together, the said joining means being resiliently yielding and arranged not to engage the cylinder."

specification in interpreting the claim that "this may be done with a view of showing the connection in which a device is used and proving that it is an operative device."

Included in the other opinions of this Court on the subject is the statement in *Carnegie v. Cambria,* 185 U. S. 403, 432, as follows:

> "The claim of a patent must always be explained by and read in connection with the specification."

In *Carnegie v. Cambria* the situation was precisely identical with the question at bar and the Court of Appeals in the instant cause followed faithfully the practice of this Court in the cited case. In the cited case the claim was for a "method of mixing molten metal." The question arose as to whether this included cupola metal or blast furnace metal. It was argued that if it included cupola metal, the claim was invalid. The Court referred to the specification and found that the specification referred to the use of the process with metal tapped from different "blast furnaces," and did not contain any reference to cupola metal. Hence, the claim was interpreted in the light of the specification to refer to blast furnace metal and not cupola metal, just as the Court in the instant cause has referred to the specification to find that the webs recited in the claims are flexible.

The practice has become textbook law (see *Walker on Patents, Deller Edition,* pp. 1242 and 1243).

In the case of *Permutit v. Graver* relied upon by our adversaries, there was nothing in the specification from which to interpret the bed as being a free bed. This is apparent from the following sentence taken from this Court's opinion in that cause:

> "The free bed was neither described in the specification nor claimed in either claim 1 or claim 5."

It is very apparent that if the free bed had been described in the specification as the flexible web is described

in the Jardine specification and the blast furnace metal was described in *Carnegie v. Cambria,* this Court, in *Permutit v. Graver,* would have gone to the specification for a construction of the bed, just as this Court did in *Carnegie v. Cambria.*

Throughout the defendant's discussions and presentations in these causes there has been a persistent confusion of the rule of the construction of a claim in the light of the specification, such as stated in *Carnegie v. Cambria,* and the rule that an element cannot be read into a claim, as stated in *McCarty v. Railroad Company.* We do not know of any way the patent law could be more muddled up and bogged down than by confusion of the application of these two rules. We recognize that under the rule of *McCarty v. Railroad,* webs could not be read into the Jardine claims, but it is just as true that with the webs in the claims, the claims may be construed in the light of the specification to interpret the webs as being flexible webs. This confusion is carried by the defendants to the case of *Greenwalt v. American Smelting,* cited at the bottom of page 17 of the defendants' brief. In the case cited, the plaintiff's claims recited a hood as an element. The Court would not permit this element to be read out of the claim. We might say it did not matter whether its presence in the claims was due to an interference or to some other cause, it could not be read out of the claims any more than the webs could be read out of the Jardine claims, but that is a far cry from saying that the hood or the web could not be construed in the light of the specifications.

That this Court make a rule of law that there shall be a different standard for disclosure of a prior use than for a prior patent or publication, as defendants request, is not only contrary to the established practice, but its fal-

lacy is manifested by the contentions which defendants make in its support. It is said at the bottom of page 19 of defendants' brief that the Long piston was made in a core box and pattern which always have the same characteristics. This might be true, and yet be of no aid because all pistons are machined after being cast, and the Long piston is no exception to this rule. The ultimate characteristics of the piston are determined by the machining. Characteristics of the casting are changed by the machining. For example, as cast none of the parts are capable of being flexed or distorted or deflected. Only after the machining and cutting is concluded might these properties appear in the piston, and whether they do appear or not depends upon the kind of machining and the relation of the parts after some are cut free from others. We do not mean to say by this that webs as rigid as the Long webs could be made flexible by machining, but that webs which are as flexible as the Jardine webs may, by machining and cutting, so operate. There are many ways in which the castings made in the Long core box and pattern might have been machined and cut, and the characteristics of the resulting piston would have depended upon the kind and plan of machining and cutting. The proposed rule is unsafe also because, devices, and this is true of pistons, change in structure and operation due to wear and due to distortions and other changes resulting from exposures to heat, pressure, and the like. When one considers the making of such a general rule as this Court is here requested by defendants to make, one must think of its application to structures more subject to change and modification by time and usage than pistons for, manifestly, one rule cannot be made to apply to one device and another rule to another device. In many devices, and this is true of pistons, the characteristics of the material of which the pis-

ton is made are changed by temperature, pressure and the like. It is seldom, if ever, that a device bears the date of its manufacture and first use so that the question of its antiquity is always an open question. Moreover, such things as molds and patterns are very frequently changed as devices made by them are abandoned and other newer models made; these changes are to adapt the molds and patterns to the later models. None of these things are true of publications. Thus, it is apparent that not only should the rule proposed by defendants not be instituted, but that there is much justification for the present decisions which, if anything, place a heavier burden upon he who asserts a public use than upon he who produces a prior publication or patent.

Moreover, if this rule were to be adopted, to be consistent this Court must reverse its former opinion because, as the record shows, many pistons of the Maynard patent were made and marketed and if flexibility could be read into the webs of a piston by duplicating the commercial Maynard pistons, there would have been no need of describing the flexibility in the Maynard patent because, manifestly, if a piston, which is described, in the patent upon it as rigid, as is true of the Long piston, could be rescued from that situation by the duplication of one of the commercial Long pistons, it would not be consistent to withhold from Maynard a ruling to the same effect when his patent was silent upon the question of flexibility. It is also manifest that in the application of such a general rule a party who took out a patent in addition to commercializing his piston should not be deprived of the benefit of the rule because he took out a patent and added to the disclosure of the commercial device itself, whether it was capable of being duplicated or not.

Thus, it is apparent that there is all the more reason for applying the "strict rule" of disclosure made the law

of these causes in this Court's former decision to a prior use than to a publication or patent to which this Court applied it.

II.

Petitioner's brief p. 18.

The Court of Appeals did not decide that in order to make the Long piston an anticipation Long must have understood "the scientific explanation of the mode of operation of the Long pistons."

As a matter of fact, Mr. Long did understand "the scientific explanation of the mode of operation of the Long pistons" and described it in his patent. As we have pointed out elsewhere, flexible webs would be incompatible with and repugnant to this principle of operation which Long described. Defendants complain that the Court of Appeals accepted "the scientific explanations of the mode of operation of the Long pistons" made by Long, and here defendants ask this Court to reject Long's explanation and accept an erroneous, made-for-this-litigation hindsight theory of defendants. Moreover, "the scientific explanation of the mode of operation of the Long pistons" made by Long is consistent with the rubbing found upon Exhibit F (R. p. 1009) and is supported further by the following appearing at the bottom of page 939 of the record:

> "This particular piston head shows that the side opposite from the one bearing the exhibit tag, *has collapsed in service.* The gases have been blowing clear by the piston, as shown by the excessive carbon deposits at the bottom of the skirt under that boss. There has also been *some collapse* apparently in one of the thrust face sections, as shown by the carbon accumulation on it. There has also been *fairly hard rubbing* on one or the other thrust faces just opposite the end of one of the cross webs. So that,

apparently, this particular piston did not function properly in service." (Emphasis ours throughout unless otherwise indicated.)

It is the rigid action of the webs which caused the rubbing and the collapse. If the webs had flexed and yielded, there would neither have been rubbing nor collapse because the forces which caused the rubbing and collapse would have been ineffective to have caused either, if the webs had yielded.

We have pointed out in the statement of facts (*supra* pp. 14-26) that the Long piston, in the form shown by Exhibit F and by his patent 1872772, was so constructed (as in both the drawing of the patent and the form of Exhibit F) that the "connectors 10" (even assuming they are "webs") could not, and therefore did not, bend or yield or flex while the piston was in operation, and that this was a sufficient reason, and the probable reason, why these pistons never could be fitted in the Franklin engine with a clearance of less than 5/1000, and therefore never did solve the problem. It is for this reason alone quite unimportant to inquire into Long's knowledge of the scientific explanation," for the scientific explanation of a thing that does not happen is quite academic.

The fact that the connectors or webs of Long could be bent when the piston was not in use does not prove that Long's "scientific explanation of the mode of operation" of his pistons made by him in his patents is erroneous when the Long pistons were in use. On the other hand, this wearing affirms Long's explanation of the operation of his piston. The history of the Long piston also affirms Long's explanation of its principle of operation (R. p. 1010).

It seems to us quite obvious that any ordinary observer looking at Exhibit F, just as our expert was looking at it when he made the supposed "concession," would

understand that while the "connectors 10," might bend somewhat, depending upon the conditions of heat and tension which might develop, yet would have ample basis for positively concluding that there would be no such bending in use in view of the scoring caused by the failure of the Long webs to bend (R. p. 1009).

Petitioner's brief cites no authority, and we think there is none, for the idea that there is any difference in the character of the disclosure which is made between a written description which does not explain the non-obvious character or operation of a physical element and a physical embodiment of the device where the operation or character of a visible element is not obvious. The cases are familiar which hold that a method patent is not anticipated by an earlier device which the observer can later see might have operated according to the later patented method. (*Carnegie v. Cambria, supra.*)

So the cases hold that though the quality of an element in an earlier structure might have possessed the quality of the same element shown and described in a later patent, there is no anticipation if the quality in the earlier structure developed only accidentally or incidently and was not understood. (*Walker on Patents,* 6th Ed., Sec. 106.)

III.

There was no error in issuing the injunction against Exhibit 1.

It is familiar law that the owner of legal title to a patent, in order to obtain injunctive relief, should join an exclusive licensee but need not join licensees who are not exclusive. In spite of this rule, and in spite of the fact that the claim that the Aluminum Company of America should have been joined because an exclusive licensee was made before the Master and was overruled

by him and was by petitioners never in any form preserved for review and was never presented to the Court of Appeals upon the first hearing, petitioner is now trying to raise the point at this time in this court. Petitioner's brief attempts to disguise this situation by saying its present claim is not generally that the Aluminum Company of America is an exclusive licensee, but is specifically that Exhibit 1, which was enjoined, is an all aluminum piston and that the plaintiff has by its contract with the Aluminum Company prevented itself from making or licensing others to make an all aluminum piston under the patent in suit.

(The Master's report (pp. 11-13) would indicate that the question in the specific form was the one raised before the Master and that his conclusion involved overruling of the defendant's contention. The precise form in which the question is now attempted to be presented is therefore the precise form in which it was presented to the Master and overruled and in which ruling there was entire acquiescence from that time until defendant attempted in a few brief words to present it to the C. C. A., not in its brief upon the supplemental hearing after remand, but in its brief in separate appeals which had been taken from the final decrees then in the District Court upon the original remand from the C. C. A. to the District Court (pp. 2 and 3 in the brief in appeals Nos. 8094-96). The C. C. A. held that the point could not be considered because the question had not before been judged in favor of plaintiff and it was not open to review.)

Contrary to the representation of the defendants, there is nothing novel about the patent law proposition that the presence of the full title to a patent in a patentee is not modified by the grant of exclusive licenses to particular fields. As early as 1890 this Court, in *Waterman v. McKenzie, supra,* laid down the rule that has been

followed ever since that any license less than the entire monopoly, i.e., the exclusive right to make, use and sell for all fields and all purposes, was nothing less than a non-exclusive license, leaving the entire title in the owner of the patent who must enforce all rights under the patent. This was for the very sound reason that otherwise the owner of a patent could split the monopoly which had been granted to him up into any number of monopolies by granting an exclusive license to each of any number of fields of use. For example, as we have said, if the rule of law which the defendants urge this Court to follow in Section III of their brief were accepted, Aluminum Company of America would have an exclusive monopoly for aluminum pistons and The Cleveland Trust Company could grant an exclusive right and monopoly to another for the iron piston field and to another for the nickel piston field, and so on, *ad infinitum*. This the Supreme Court said would put the patentee in the business of granting monopolies, a function reserved by the Congress for the Commissioner of Patents. The change in this rule which defendants urge would cause limitless confusion and muddle in the patent practice.

CONCLUSION.

There being no basis in this Court's practices for the granting of the petition and it being demonstrated that it is unwise to make the bad law which defendants ask, we think the petition should be denied.

Respectfully submitted,

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